



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/786,578

02/23/2004

Kevin C. Farrell

CM06657LL

4367

24273 7590 12/21/2005

MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
LAW DEPT
8000 WEST SUNRISE BLVD
FT LAUDERDAL, FL 33322

EXAMINER

JOHNSON, JONATHAN J

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,207,475 (Lin). Lin teaches a solderable substrate having an adhesive material applied to a portion of the solid solder element so as to overlap with the solderable substrate outside of a predefined area reserved for subsequent component placement (fig. 5f, items 48 and 84), the adhesive material immobilizing the solid solder element during reflow (col. 10, l. 12-32); the adhesive material overlapping the solderable substrate and the solid solder element, the adhesive material cured so as to immobilize the solid solder element; and the component subsequently being coupled to the solderable substrate via the solid solder element during a reflow process (col. 10, ll. 10-65); wherein the component is at least one of mechanical, electrical, and electromechanical components (abstract); wherein the adhesive material is characterized by a predetermined application viscosity, predetermined volume reduction during the reflow process, retention of adhesive qualities during the reflow process, and an inability to mix with the solid solder element during the reflow process (col. 10, ll. 10-65).

Response to Arguments

Applicant argues the teachings of Lin does not perform the same function as applicant's invention. The examiner agrees. Applicant goes on to argue that Lin does not anticipate the claims. The examiner disagrees. The examiner understands that, as with any other claim limitation, functional language is acceptable so long as it sets definite boundaries on the patent protection sought. In *re Barr*, 170 USPQ 33 (CCPA 1971). If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). To put it another way: While the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In the instant case, as stated in the previous office action, it is the examiner's position that the adhesive material and the interface apparatus of Lin is capable of performing in the claimed manner. Applicant has neither argued or provided any extrinsic evidence showing that adhesive material and the interface apparatus of Lin cannot performed in the claimed manner. The rejection is maintained despite applicant's traversal.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

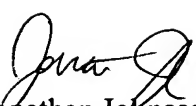
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/786,578

Page 5

Art Unit: 1725


Jonathan Johnson
Primary Examiner
Art Unit 1725

jj